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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,802	01/30/2004	Tsunehiko Baba	500.43447X00	3131
24956	7590	08/24/2005	EXAMINER	
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314				KRAVETS, LEONID
ART UNIT		PAPER NUMBER		
		2189		

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/766,802	BABA ET AL.	
	Examiner Leonid Kravets	Art Unit 2189	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 January 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 January 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>20050816</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/30/2004</u> . | 6) <input type="checkbox"/> Other: _____. |



Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 2003-057937, filed on March 5, 2003.

Information Disclosure Statement

2. Acknowledgment is made of applicant's information disclosure statement submissions on March 18, 2005 and January 30, 2004.

Drawings

3. The drawings are objected to, changes in the text of the drawings are required corresponding to the changes required in the specification.

Specification

4. The disclosure is objected to because of the following informalities.
35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: living party computer, monitor section and party switchover section. Further, numerous grammatical errors are found throughout the specification.

Appropriate correction is required.

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-13 are replete with errors that must be corrected in order to comply with the code set out by 35 U.S.C. 112. Some of these are outlined below:
 - a. It is unclear in claim 1 whether the living party computer or the program holds the disk management information buffer of lines 2 and 3.
 - b. The scope of "making the correspondence" is unclear
 - c. The process for making a decision outlined in the sixth paragraph is unclear.
 - d. There is unclear antecedent basis for the first computer and second computer (first found in second paragraph of claim 2).
 - e. It is impossible for "first computer to determine....transmission to said second computer of a notice...".

8. The above are some of the errors found, examiner notes that other errors exist and must be corrected for compliance with 35 U.S.C. 112.

Claim Rejections - 35 USC § 102

9. Examiner uses the following guidelines in applying art to the claims of this disclosure: A claim limitation which is considered indefinite cannot be disregarded. If a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 U.S.C. 112, second paragraph (see MPEP § 706.03(d)) and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984) (Claims on appeal were rejected on indefiniteness grounds only; the rejection was reversed and the case remanded to the examiner for consideration of pertinent prior art.). Compare *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970) (if no reasonably definite meaning can be ascribed to certain claim language, the claim is indefinite, not obvious) and *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

10. Thus, art is applied for claims 2, 3, 4, 5, 8, 9, 10, 11 as described below. No art could be applied for claims 1, 6, 7, 12 and 13 in compliance with the decision of *In re*

Steele. Examiner notes that further explanation of the claims could lead to a prior art rejection.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12. Claims 2 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Ichikawa et al. (US Pub. No. 2004/0139205).

13. As per claim 2, Burton discloses a party switchover method in a computer system having a living party computer, a standby party computer for taking over processes of said living party computer and a disk device for storing volumes shared by said living

party computer and said standby party computer [a hot standby system configuration comprising a primary server, a standby server and a shared disk unit], comprising;

A first step of causing said first computer to decide whether a volume identifier stored in a volume is changed [Burton describes updating a management table by registering or deleting volume IDs (Paragraph 50)]; and

A second step of causing said first computer to determine, in accordance with the result of said decision, transmission to said second computer of a notice to the effect that said volume identifier is changed [Each computer has the management table, thus when a volume ID is registered or deleted, a notice must be given to each computer's management table (Fig 1, ref. 1200 and 2200 and Fig 2, ref 1295)].

14. As per claim 8, Ichikawa discloses a first computer connected to a memory unit including volumes shared by said first computer and a second computer (Fig 1, Ref 1000, 2000, 3000), comprising;

A monitor section for detecting that a volume identifier stored in a volume is changed [Burton describes updating a management table by registering or deleting volume IDs (Paragraph 50)]; and

A party switchover section for determining in accordance with the result of said decision, transmission to said second computer of a notice to the effect that said volume identifier is changed [Each computer has the management table,

thus when a volume ID is registered or deleted, a notice must be given to each computer's management table (Fig 1, ref. 1200 and 2200 and Fig 2, ref 1295)].

15. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

Claim Rejections - 35 USC § 103

16. Claims 3-5, 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichikawa as applied to claim 2 above, and further in view of Overfield (US Patent 5,598,577).

As per claim 3, Ichikawa discloses a party switchover method according to claim 2. Ichikawa does not disclose further sending the physical device name of a copy volume whose volume identifier is changed. Overfield discloses sending such a physical device name of a copy volume, and provides the motivation for doing so. Overfield discloses updating a table with device names. The motivation for using device names and not simply the device parameters is to avoid the possibility of a device matching some parameters of another device, but not all, thus avoiding misrecognition (Col 4, lines 38-43).

As per claim 4, the combination of Ichikawa and Overfield discloses a party switchover method according to claim 3, wherein said second computer has a buffer holding a table for storing physical device names of volumes and volume identifiers by making the correspondence between said physical device names and said volume identifiers (Ichikawa, Fig. 8); said method further comprising a fourth step of causing said first computer to decide, in accordance with the result of said decision in said first step, whether information is transmitted to said second computer, said information being adapted to designate a method of changing said volume identifier stored in said buffer in correspondence with said physical device name transmitted to said second computer (Paragraph 50).

As per claim 5, the combination of Ichikawa and Overfield discloses a party switchover method according to claim 4, wherein said information adapted to designate the change method in said fourth step includes a designation as to whether said volume identifier stored in said buffer is to be erased (Paragraph 50).

As per claims 9, 10, 11 please see rejections of claims 3, 4, 5 above. These claims are rejected for similar reasons.

Conclusion

16. The following is text cited from 37 CFR 1.111(c): In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

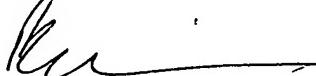
17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonid Kravets whose telephone number is 571-272-2706. The examiner can normally be reached on M-F, 8-4:30.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim can be reached at (571)272-4182. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

L.f.
Leonid Kravets
Patent Examiner
Art Unit 2189


BEHZAD JAMES PEIKARI
PRIMARY EXAMINER

August 19, 2005